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APPLICATION NO. FILING DATE FIRST NAMED INVENTOR ATTORNEY DOCKET NO.

09/089,789

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06/03/98

SHORT

HM22/1003

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EXAMINER

MCGARRY, S

ART UNIT PAPER NUMBER

1635

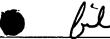
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DATE MAILED:

10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks



Office Action Summary

Application No. 09/089,789

Applicant(s)

Short et al

Examiner

Sean McGarry

Group Art Unit 1635

| Responsive to communication(s) filed on | • |
|--|---|
| ☐ This action is FINAL . | |
| ☐ Since this application is in condition for allowance except for f in accordance with the practice under <i>Ex parte Quayle</i> , 1935 | |
| A shortened statutory period for response to this action is set to e is longer, from the mailing date of this communication. Failure to application to become abandoned. (35 U.S.C. § 133). Extension 37 CFR 1.136(a). | respond within the period for response will cause the |
| Disposition of Claims | |
| | is/are pending in the application. |
| Of the above, claim(s) | is/are withdrawn from consideration. |
| Claim(s) | is/are allowed. |
| Claim(s) | is/are rejected. |
| ☐ Claim(s) | |
| | are subject to restriction or election requirement. |
| Application Papers | |
| \square See the attached Notice of Draftsperson's Patent Drawing I | Review, PTO-948. |
| ☐ The drawing(s) filed on is/are objected | d to by the Examiner. |
| ☐ The proposed drawing correction, filed on | is 🗆 approved 🗆 disapproved. |
| $\hfill\Box$ The specification is objected to by the Examiner. | |
| $\hfill\Box$ The oath or declaration is objected to by the Examiner. | |
| Priority under 35 U.S.C. § 119 | |
| Acknowledgement is made of a claim for foreign priority ur | nder 35 U.S.C. § 119(a)-(d). |
| ☐ All ☐ Some* ☐ None of the CERTIFIED copies of t | the priority documents have been |
| received. | |
| received in Application No. (Series Code/Serial Numb | |
| received in this national stage application from the In | |
| *Certified copies not received: | |
| ☐ Acknowledgement is made of a claim for domestic priority | under 35 U.S.C. § 119(e). |
| Attachment(s) | |
| □ Notice of References Cited, PTO-892 | |
| ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s | s) |
| ☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948 | |
| □ Notice of Informal Patent Application, PTO-152 | |
| | |
| SEE OFFICE ACTION ON TH | E FOLLOWING PAGES |

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Application/Control Number: 09/089,789

Art Unit: 1635

Page 2

Election/Restriction

- 1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-38, drawn to a method of forming a catalogued nucleic acid library from an organism sample comprised of a plurality of organism forms, classified in class 435, subclass 6.
 - II. Claims 39-42, drawn to a nucleic acid library formed from a plurality of organisms, classified in class 536, subclass 23.1.
- 2. The inventions are distinct, each from the other because of the following reasons: Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the nucleic acid library can be made by a materially different process since, for example, the method of Group I is drawn to an initial sample form of a plurality of organism forms and the library of Group II is formed from a sample comprising only a plurality of organisms that are not necessarily different organism forms.

Application/Control Number: 09/089,789

Art Unit: 1635

3. Because these inventions are distinct for the reasons given above and have acquired a

Page 3

separate status in the art as shown by their different classification, restriction for examination

purposes as indicated is proper.

4. Because these inventions are distinct for the reasons given above and have acquired a

separate status in the art because of their recognized divergent subject matter, restriction for

examination purposes as indicated is proper.

5. Applicant is advised that the reply to this requirement to be complete must include an

election of the invention to be examined even though the requirement be traversed (37

CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the

inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently

named inventors is no longer an inventor of at least one claim remaining in the application. Any

amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the

fee required under 37 CFR 1.17(I).

7. Any inquiry concerning this communication or earlier communications from the examiner

should be directed to Sean McGarry whose telephone number is (703) 305-7028.

Application/Control Number: 09/089,789

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Art Unit: 1635

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003.

Certain papers related to this application may be submitted to Art Unit 1635 by facsimile transmission. Papers should be faxed to Art Unit 1635 via the PTO Technology Center Fax

Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see C.F.R. 1.6(d)). The Art Unit 1635 FAX number is (703) 308-4242 or (703) 305-3014. NOTE: If Applicant does submit a paper by Fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October 2, 2000

Technology Center 1600

Page 4